

REMARKS

I. Election

The applicants hereby elect restriction group I, claims 1-38. With respect to the election of species, the applicants elect SEQ ID NO: 33.¹

II. Traversal of Restriction

Citing 35 U.S.C. 121, the examiner alleged that claims 1-74 of the application were directed to 16 distinct inventions, and required restriction. The examiner further required an election of polypeptide species within the elected group. The applicants respectfully traverse.

The Patent Office is only permitted to restrict inventions that are independent and distinct. The examiner has alleged 16 different restriction groups, but has failed to set forth any valid basis for concluding that the groups are distinct.

The examiner restricted groups I and II because they "are unrelated." In actuality, the groups are intimately related. Group I is directed to specific peptides as well as homodimers of the peptides. The claims of group II all depend from claims of group I, and are directed to heterodimers. Because of the dependency, all of the claims of group II recite, as an element, a peptide of group I. The requirement of a peptide of group I represents a fundamental relationship between the two groups. Because the group II heterodimers recite a peptide of group I, the examiner's search of group I will be sufficient to examine group II for purposes of novelty and unobviousness. The examiner has not and cannot point to any art that the examiner would search for group I or group II that would not also be relevant to the other group. Upon a finding that claims of group I are novel and unobvious, the

¹ If this species election is unacceptable then the applicants elect SEQ ID NO: 35.

examiner has not articulated any basis for concluding that the claims of group II would not also be novel and unobvious. For all these reasons, the examiner (a) has not met the burden for restricting groups I and II and (b) has restricted these groups improperly.

The foregoing analysis also applies to each subsequent pair of groups (e.g., 3-4; 5-6; 7-8; and so on). The sole basis for restricting these pairs of groups is the improper notion that a heterodimer comprising two peptides is "unrelated" to a monomer or homodimer of the peptides. It is impossible for a monomer to be "unrelated" to a heterodimer when the heterodimer must include, as a component, the monomer. Thus, the "same/different" basis for restriction is improper, and the number of groups should be reduced from 16 to 8 on this basis alone.

Referring now to the method groups (3-16), the sole basis for a restriction was again that the groups were "unrelated." Analysis of the groups and the claims demonstrates that this is not correct. For example, groups 3-6 all pertain to an invention defined by claims 39-43. It is impossible for a method defined by a single claim (e.g., claim 39) to be "unrelated" to itself. The same analysis applies with respect to groups 7-10 (all include claims 44-46); and claims 11-12; and claims 13-14; and claims 15-16.

Groups 3-10 all pertain to "a method of inhibiting the proliferation of a cell ..." It should be self-evident that these groups are related in this respect. Moreover, they are related in that the groups all specify use of the same peptides (either as monomers, homodimers, or heterodimers) or use of a nucleotide sequence encoding the specified peptide. The relatedness of a peptide and a nucleotide sequence that encodes it is self-evident. Referring to groups 11-16, all of these method claims pertain to methods of screening or imaging. They all involve a step of

contacting biological material with a composition comprising a peptide of the invention; and evaluating binding of the peptide in the biological material. With respect to these groups, the examiner appears to have restricted the claims simply because claims 65-74 include three independent claims; and not by consideration of the steps recited in the claims. There would be no burden in examining all of these claims together, and they should be regrouped into a single restriction group.

Even with independent and distinct inventions, the MPEP instructs that an examiner should only restrict the inventions if examination of inventions together would pose a serious burden. No such burden has been demonstrated here. The examiner alleged, "it is an undue burden for the examiner to search more than one invention." That simple statement, however, is insufficient. If there were a *per se* rule that searching more than one invention was a burden, the MPEP would not provide the guidance to search more than one invention when possible. For several decades, examiners in the chemical arts have examined patent applications claiming thousands or even millions of related chemical compounds. The notion that it is an undue burden to search more than one invention represents a clear departure from accepted Patent Office practice, and would work to the severe detriment to the entire chemistry and biotechnology industries.

Paragraph 5 of the restriction requirement illustrates this point nicely. The examiner states that "the applicant is required to elect a specific peptide or a specific combination of peptide for the dimer comprising the specific SEQ ID NOs." Under the current restriction requirement, the applicants would be required to file over 600 divisional applications simply to protect the first 40 preferred peptide embodiments of the invention, heterodimers comprising the same, and methods of using the same ($40 \times 16 = 640$). It should be apparent that examination of the present

application is not that complicated, and a more reasonable restriction is in order.
Reconsideration is respectfully requested.

IV. Identification of Claims Readable on Elected Species

In Section VI of the restriction, the examiner required a listing of all claims readable on the elected species, namely SEQ ID NO: 33. At least claims 1-13, 18, 23, and 24-74 read on the elected peptide (or dimers comprising in the same, or uses thereof).

If election of SEQ ID NO: 33 is unacceptable, the applicants hereby elect SEQ ID NO: 35. (See claim 13.) Claims that read on SEQ ID NO: 35 include at least claims 1-13, 21-38. Additionally, method claims 39-74 read on the use of the elected species.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300

By: _____



David A. Gass
Reg. No: 38,153

March 5, 2004